

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS J. PALERMO  
and  
PHONG PHAM

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Appeal No. 96-2562  
Application 08/214,858<sup>1</sup>

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ON BRIEF

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<sup>1</sup> Application for patent filed March 18, 1994. According to appellants, the application is a continuation of Application 07/975,376, filed November 13, 1992, now U.S. Patent 5,350,397, issued September 27, 1994.

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Before CALVERT, FRANKFORT and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3 through 5 and 14 through 16, which are all of the claims remaining in this application. Claims 2 and 6 through 13 have been canceled.

Appellants' invention relates to a detachable embolic coil for use in a surgical instrument that allows such coil to be delivered to a selected site within the vasculature of the human body via use of a catheter. As explained on page 1 of appellants' specification, the invention more particularly involves

an embolic coil having a radially enlarged member attached to one end, which coil is released by forcing the radially enlarged member axially through a distensible aperture situated on the distal end of a pusher assembly.

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Claim 1 is representative of the subject before us on appeal, and reads as follows:

1. A detachable embolic coil comprising a coil with a diameter and further having a proximal and a distal end and having a radially enlarged ball member larger than said coil diameter fixedly attached to one of said ends.

The sole prior art reference of record relied upon by the examiner as evidence of obviousness of the claimed invention under 35 U.S.C. § 103 is:

Marks	5,217,484	June 8, 1993
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In addition to the foregoing prior art, the examiner has also relied upon appellants' prior U.S. Patent No. 5,350,397, issued September 27, 1994, in a double patenting rejection.

Claims 1, 3 through 5 and 14 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Marks.

Claim 1, 3 through 5 and 14 through 16 stand additionally rejected under the judicially created doctrine of

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double patenting over appellants' prior U.S. Patent No.  
5,350,397.

Rather than reiterate the examiner's full explanation of the basis for the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the final rejection (Paper No. 10, mailed May 15, 1995) and examiner's answer (Paper No. 15, mailed February 20, 1996) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 14, filed January 22, 1996) for appellants' arguments thereagainst.

#### OPINION

At the outset, we note that appellants' brief, at page 3, indicates that the claims on appeal "may be grouped together," which statement we take as meaning that the claims on appeal stand or fall together.

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In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art Marks reference, and to the respective positions articulated by appellants and the examiner. Upon evaluation of all of the evidence before us, we have reached the conclusions which follow.

Looking first to the examiner's rejection of the appealed claims under "the judicially created doctrine of double patenting," we note appellants' comment on page 6 of the brief that they have "offered to file a terminal disclaimer under 37 C.F.R. 1.321." However, no such terminal disclaimer has been filed and appellants have not otherwise presented any argument

against the examiner's rejection. As a result, we are compelled to summarily affirm the examiner's rejection based on double patenting.

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As for the rejection of claims 1, 3 through 5 and 14 through 16 under 35 U.S.C. § 103, we find appellants' arguments on pages 4-6 of the brief to be persuasive of error on the examiner's part. Like appellants, we are of the opinion that the examiner's analysis regarding this rejection constitutes improper hindsight reasoning based upon appellants' own teachings and not upon any reasonable teaching or suggestion found in the applied prior art reference to Marks. The examiner's contention (answer, page 4) that to change the ball size in Marks to be of a diameter which is radially larger than the diameter of the coil therein would have been "simply an obvious design modification known to one skilled in the art," has no evidential basis in the record before us and is based purely on speculation.

In accordance with the foregoing, we have sustained the examiner's rejection of claims 1, 3 through 5 and 14 through 16 under the judicially created doctrine of double patenting, but reversed the examiner's rejection of these same appealed claims

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under 35 U.S.C. § 103 based on Marks. Since at least one rejection of all of the claims on appeal has been sustained, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

	IAN A. CALVERT	)	
	Administrative Patent Judge	)	
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		)	
		)	BOARD OF
PATENT		)	
	CHARLES E. FRANKFORT	)	APPEALS AND
	Administrative Patent Judge	)	INTERFER-
ENCES		)	
		)	
		)	
	MURRIEL E. CRAWFORD	)	
	Administrative Patent Judge	)	

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